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Patent
Serial No: 09/240,250
Atty. Docket No. 12832-100168

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Brian Paul Boesch

Serial No.: 09/240,250

Filed: January 29, 1999

For: E-MAIL INVOKED ELECTRONIC COMMERCE
(As Amended)

Examiner: Chuong H. Nguyen

Art Unit: 3661

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

Sir:

Attached hereto is Appellants' Brief for the above-referenced application.
The Commissioner is authorized to charge the requisite fee \$500.00 (37 CFR
1.17(c) and all other fees associated with this submission, to Deposit Account
No. 11-0600.

Respectfully submitted,

Date: July 14, 2005


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PATENT
Serial No: 09/240,250
Docket No: 12832-100168

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Brian Boesch

Serial No: 09/240,250

Filed: January 29, 1999

For: A SYSTEM AND METHOD FOR E-MAIL
INVOKED ELECTRONIC COMMERCE USING A
WALLET

Examiner: Cuong H. Nguyen

Art Unit: 3661

APPEAL BRIEF Under 37 CFR 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

Sir:

Applicants submit this Appeal Brief in the above-referenced application. A Notice of Appeal was filed on March 14, 2005, and an extension for time under 37 CFR 1.136 is hereby authorized to be charged to deposit account 11-0600.

REAL PARTY IN INTEREST

Verisign, Inc. is the real party in interest for all issues related to this application by virtue of assignments filed with the USPTO on August 5, 2002.

RELATED APPEALS OR INTERFERENCES

There are no other appeals, interferences, or judicial proceedings known to Appellants, appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

07/15/2005 JADD01 00000025 110600 09/240250

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STATUS OF CLAIMS

This application contains claims 1-93. Claims 1-79 have been canceled. Claims 80-93 stand finally rejected as obvious over prior art and are the subject of this appeal.

STATUS OF AMENDMENTS

No Amendments After Final Rejection were filed in this application.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 80 recites a method for conducting electronic transactions over a network (network 160, Fig. 1, pages 10-18) comprising, at a merchant computer (merchant computer 122, page 11, ll. 3-6) sending, to a consumer computer (consumer computer 102, page 11, ll. 19-23) an electronic mail message associated with an electronic transaction (merchant's offer sent to consumer computer 202, page 14, ll. 1-2, which may be an e-mail message, page 22, ll. 7-10, page 24, ll. 5-6), the electronic mail message including a link to a consumer information server (e-mail message contains links to consumer information server 140, page 22, ll. 7-10), and, at the consumer information server: receiving, from the consumer computer, a connection based on the link, (page 14, ll. 15-18), sending, to the consumer computer, a request for registration information (page 16, ll. 16-18, page 22, ll. 12-13, page 24, ll. 18-19), receiving, from the consumer computer, registration information in response to the request (page 22, ll. 18-20, page 24, l. 23-page 25, l. 2), the registration information including a consumer identification number (page 22, ll. 13-16), and storing the information (consumer response are stored, page 23, ll. 3-4).

Independent claim 93 recites a method for conducting electronic transactions over a network (network 160, Fig. 1, pages 10-18), comprising, at a merchant computer (merchant computer 122, page 11, ll. 3-6) sending, to a consumer computer (consumer computer 102, page 11, ll. 19-23) a first electronic mail message having a link including an Internet address of a consumer information server (e-mail message contains links to consumer information server 140, page 22, ll. 7-10, links can be Internet address, page 23, ll. 20-21) at the consumer computer: selecting the link contained within the first electronic mail message received from the merchant computer (page 23, l. 23- page 24, l. 2), and sending a connection request to the Internet address of the consumer information server (page 24, ll. 1-2), and, at the consumer

information server: sending, to the consumer computer, a request for registration information in response to the connection request received from the consumer computer (page 16, ll. 16-18, page 22, ll. 12-13, page 24, ll. 18-19) receiving, from the consumer computer, registration information in response to the request, the registration information including a consumer identification number, a consumer electronic mail address and a consumer passphrase (page page 22, ll. 13-22), storing the registration information (consumer response are stored, page 23, ll. 3-4), and sending, to the consumer computer, a second electronic mail message indicating that the registration information was stored (page 23, ll. 4-5).

GROUND OF REJECTION TO BE REVIEWED

The Final Rejection rejects claims 80-86 and 88-92 under 35 U.S.C. §103 over Stein (USP 6,246,996), rejects claim 87 under 35 U.S.C. §103 over Stein in view of Wiser (USP 6,385,596), and rejects claim 93 under 35 U.S.C. §103 over Stein in view of Wiser and further in view of Official Notice.

ARGUMENT

The Final Rejection fails to establish a *prima facie* case of obviousness for any of the claims on appeal, improperly ignores claimed features, and does not point out where in the applied Stein patent the claimed features are disclosed. The Final Rejection improperly takes Official Notice of elements of the claims without providing any support for the Official Notice, despite Appellants traversal of the Official Notice and request for supporting references. Details of these arguments are presented below.

A. Claims 80-86 and 88-92 Are Not Obvious Over Stein

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Further, the Examiner must not only identify the elements in the prior art, but also show some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988). Such evidence is required in order to establish a *prima facie* case of obviousness. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

The Examiner has failed to establish a *prima facie* case of obviousness in rejecting the claims on appeal. In the Final Rejection, the Examiner asserts that Stein teaches the following from Appellant's claim 80:

80. A method for conducting electronic transactions over a network, comprising:
at a merchant computer:
sending, to a consumer computer, an electronic mail message associated with an electronic transaction, the electronic mail message including a link to a consumer information server;

The Final Rejection asserts that the electronic mail message including a link to a consumer information server is "a structural communication between a seller (ref. 28) and an Internet server (ref. 12) see Stein Fig. 7." See Final rejection pages 2-3. The Final Rejection does not point to any sending of an e-mail message including a link to a consumer information server in Stein, but instead somehow asserts that the e-mail message including a link to a consumer information server is met by the mere connection of a seller 28 and an Internet server 12. The Final Rejection apparently refers to the Internet 12 of Stein as both the claimed network *and* the claimed consumer information server. It is respectfully asserted that this claim interpretation is improper. Reference to Appellants specification shows that the network 160 and consumer information server 140 are separate elements. Further, the specification indicates that a consumer information server stores necessary and desirable information about the consumer. See page 5, lines 4-10, for example. The Final Rejection also ignores the recitation that the electronic message is associated with an electronic transaction.

In the Final Rejection, the Examiner asserts that Stein teaches the following from Appellant's claim 80:

at the consumer information server:
receiving, from the consumer computer, a connection request based on the link,
sending, to the consumer computer, a request for registration information,

receiving, from the consumer computer, registration information in response to the request, the registration information including a consumer identification number,

The Final Rejection again asserts that these steps are structural connections between 2 parties and a middle-man. The Examiner apparently feels that Stein only has to disclose a connection between a buyer, seller and middleman, and that this limited disclosure is sufficient to reject the claims, even if the recited steps of claim 80 are not shown in Stein. It is respectfully submitted that this rejection does not establish a *prima facie* case of obviousness, because the Examiner has not shown in Stein: sending, to a consumer computer, an electronic mail message associated with an electronic transaction, the electronic mail message including a link to a consumer information server, at the consumer information server: receiving, from the consumer computer, a connection request based on the link, sending, to the consumer computer, a request for registration information, receiving, from the consumer computer, registration information in response to the request, the registration information including a consumer identification number, as required by claim 80.

Moreover, in the Advisory Action, the Examiner states:

"Independent claim 80 is directed to a method for conducting an online transaction, comprising;

- a seller sending a message
- a "middle-man" receiving said message;
- said "middle-man" requests a consumer's registration;
- consumer provides registration info to that "middle-man".

According to that reasonable interpretation, claim 80 is obvious in view of Stein because: the applicant admits communications to achieve a transaction between a seller and a buyer including a middle-man/(a payment system)-see the Response, page 4 of 6, lines 4-22)."

The above interpretation of claim 80 is not only not reasonable, it ignores limitations of the claim. The Examiner's interpretation includes the "middle-man" receiving a message from the seller. The "middle-man" is apparently referring to the claimed consumer information server. However, claim 80 does not recite the consumer information server receiving a message from a

seller as the Examiner's improper interpretation would require. Instead, claim 80 recites that the electronic mail message is sent to the consumer computer, that the electronic mail message include a link to the consumer information server, and that the consumer information server receives a connection based on the link. Thus, the Examiner's improper interpretation of claim 80 reads the steps of the electronic mail message is sent to the consumer computer, that the electronic mail message include a link to the consumer information server and that the consumer information server receives a connection based on the link right out of the claim. It is asserted that this interpretation is improper and not in accordance with the law.

In contrast to the claimed invention, Stein discloses a payment system for transferring funds to a second user from the account of a first user who purchases from the second user an "information product deliverable over the Internet." Stein col. 2:16-20. The payment system has a front end computer and a back end computer coupled via a private network. Stein col. 4:23-26. The front end executes programs for interacting with users. Stein 4:59-64. The back end contains a full copy of user account information, Stein col. 5:55-57 and col. 6:8-10, and interacts with a settlement system. Stein col. 9:58-60. This "isolates the buyer-seller activity which occurs on the Internet from the financial and credit activity which occurs off the Internet." Stein col. 9:60-63.

Stein discloses that the buyer sends a message containing the buyer's account number ("cardnumber") to the seller, who then sends an inquiry to the payment system to determine if the buyer's account can be charged the value of the transaction. Stein col. 6:57-67 and col. 7: 5-10. The seller sends the information product to the user and a funds "transfer-request message" to the payment system to have the payment system transfer funds from the buyer's account to the seller's account. Stein col. 7:44-47. The payment system asks the buyer to authorize the transfer, Stein col. 7:59-62, and the buyer sends a "transfer-response" message to the payment system. Stein col. 8:20-23. If the buyer grants permission for the transfer, then the payment system sends a "transfer-result" message to the seller, Stein col. 8:46-49, and settles the transaction by transferring the funds. See Stein col. 9:55 et. seq.

None of the foregoing discloses or suggests the claimed invention. Stein does not disclose or suggest sending a request for registration information to a consumer computer whose user has selected a link in an received e-mail message, nor receiving registration information that includes a consumer identification number in response. On the contrary, as

described above, Stein describes a payment system that already stores consumer registration information. "In order to use the payment system 10 for transactions, the information buyer 20 and the information seller 28 both need to have subscriber or cardholder accounts with the payment system 10." Stein col. 5:12-15.

Stein neither discloses or suggests that the user receives an e-mail message containing a link that, if selected by the user, will prompt a request for registration information. Rather, Stein discloses that only that user send an "application-request message 227 over the Internet 12 to the payment system" to obtain a form through which the user can provide registration information. Stein is completely silent as to the mechanism by which such an "application-request message" is prompted or generated. Indeed, according to Stein, the user can send the "application-request message" completely on its own, without any prompting at all. Further, Stein does not disclose or suggest associating such a message with an electronic transaction. On the contrary, Stein discloses that "A cardholder application transaction occurs when Internet user 14 wishes to establish a cardholder account 100." Stein col. 12:37-39. In other words, the connection request that prompts the sending of a request for registration need not be associated with a transaction at all, but can be triggered anytime the user "wishes to establish a cardholder account."

The Final Rejection asserts that embedding "a link" in an e-mail message is considered as a non-functional descriptive material that do not contribute to a claimed step of sending a message. Final Rejection, page 1. It is asserted that the final Rejection is improperly disregarding a feature of the claimed invention, that is functional, the link is used to establish a connection with the consumer information server. This claimed feature is not in Stein.

For the above reasons, it is submitted that independent claim 80 would not have been obvious over Stein. Claims 81-86 and 88-92 would not have been obvious for the same reasons based on their dependency from claim 80. Reversal of the rejection is requested.

B. Claim 87 Is Not Obvious Over Stein in View of Wiser

It is respectfully submitted that claim 87 would not have been obvious over Stein in view of Wiser for the same reasons given above regarding claim 80, from which claim 87 depends,

and because Wiser does not cure the above-noted deficiencies of Stein. Withdrawal of the rejection of claim 87 is requested.

C. Claim 93 Is Not Obvious Over Stein in View of Wiser and Official Notice

The Final Rejection asserts that:

"All the claim limitations are already analyzed, and are rejected with the rationales and references set forth in claims 80, 87 and 92, as shown above. It would be obvious to one of ordinary skill in the art that the combination of Stein's structural configuration, Wiser's system and the Official Notice teach about an interactive and secured e-mail communication as claimed since the cited references are in the same field of endeavor that would be followed by artisans for interactive communications of 3 parties: a merchant, a customer and a server..." See Final Rejection, pages 10-11.

Because Official Notice was not previously taken, Appellants are unsure of which elements the Final Rejection is taking official notice of. The Final rejection may be referring to it's assertion:

"besides old and well known claimed limitations, the only "arguable" limitation in independent claims describing : sending a message to a server, that server would forward said message comprising a computer address, then accessing that address. This limitation has been done in computer processing because instead of putting a URL (a computer address) in an e-mail, a user can type that address in "GO TO" block on Netscape website to access that same address OR the same method has been INHERENTLY DONE by any computer server." See Final Rejection, page 2.

It is asserted that the Final Rejection has improperly paraphrased the claims of the application. For example, the claims do not recite the supposedly only "arguable" limitation of sending a message to a server, that server would forward said message comprising a computer address, then accessing that address. Further, it is not understood how "a user can type that address in "GO TO" block on Netscape website to access that same address" is relevant to the present claims, because the present claims do not recite anything about a user typing an address in GO TO block on Netscape to access or website. Further, the Office Action seems to assert that the method is inherently done on any computer. This inherency assertion iwas

previously challenged, and it was requested that the Examiner provide documentary evidence of such, which has not been done.

As indicated in *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), if the examiner is to take notice of facts beyond the record, they must be "capable of such instant and unquestionable demonstration as to defy dispute." Moreover, the Federal Circuit held it was inappropriate to rely solely on "common knowledge" (based on ones own understanding or experience-or on its assessment of what would be basic knowledge or common sense) in the art without evidentiary support. *In re Zurko*, 285 F.3d 1379, 1385 (Fed. Cir. 2001). The Federal Circuit held that such an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385.

Moreover, the Manual of Patenting Examining Procedure (MPEP) has set forth the PTO position on official notice in Section 2144.03. In particular, it is indicated that official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known are capable of instant and unquestionable demonstration of being well known. If applicant adequately traverses the Examiner's assertion of official notice, the examiner must provide documentary evidence in the next office action if the rejection is to be maintained. The MPEP cites to the *In re Zurko* and *In re Ahlert* decisions.

The Examiner has failed to properly support his assertion of Official Notice with any evidence, and the official notice should be withdrawn.

For reasons described in detail above regarding claim 80, claim 93 would not have been obvious over Stein in view of Wiser and Official Notice. The applied references do not disclose or suggest at least at a merchant computer: sending, to a consumer computer, a first electronic mail message having a link including an Internet address of a consumer information server; at the consumer computer: selecting the link contained within the first electronic mail message received from the merchant computer, and sending a connection request to the Internet address of the consumer information server; and at the consumer information server: sending, to the consumer computer, a request for registration information in response to the connection request received from the consumer computer, receiving, from the consumer computer, registration information in response to the request, the registration information including a consumer identification number, a consumer electronic mail address and a consumer passphrase, and

sending, to the consumer computer, a second electronic mail message indicating that the registration information was stored, as required by claim 93.

Accordingly, claim 93 would not have been obvious over Stein in View of Wiser and Official Notice. Withdrawal of the rejection is requested.

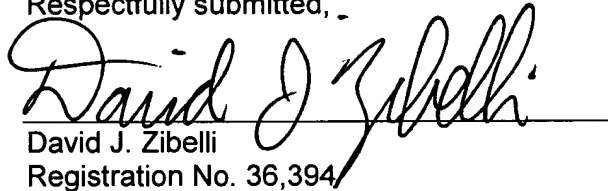
CONCLUSION

Applicant respectfully requests reversal of the rejections of claims 80-93. These claims are allowable over the cited art.

Date: July 14, 2005

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Respectfully submitted, -


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CLAIMS APPENDIX

1-79. (Canceled)

80. A method for conducting electronic transactions over a network, comprising:
at a merchant computer:

sending, to a consumer computer, an electronic mail message associated with an electronic transaction, the electronic mail message including a link to a consumer information server; and

at the consumer information server:

receiving, from the consumer computer, a connection request based on the link,

sending, to the consumer computer, a request for registration information,

receiving, from the consumer computer, registration information in response to the request, the registration information including a consumer identification number, and

storing the registration information.

81. The method of claim 80, wherein the electronic mail message includes purchase information associated with the electronic transaction.

82. The method of claim 81, wherein the purchase information includes a merchant computer uniform resource locator.

83. The method of claim 80, wherein the electronic mail message includes connection software to generate the connection request on the consumer computer.

84. The method of claim 80, wherein the link includes an Internet address of the consumer information server.

85. The method of claim 84, wherein the connection request includes the Internet address of the consumer information server.

86. The method of claim 80, wherein the registration information includes a consumer electronic mail address.

87. The method of claim 86, wherein the registration information includes a consumer passphrase.

88. (New) The method of claim 87, wherein the registration information includes consumer payment information.

89. The method of claim 88, wherein the registration information includes a consumer shipping address.

90. The method of claim 89, wherein the registration information includes a consumer shipping method.

91. The method of claim 80, further comprising:

at the consumer information server:

checking the registration information for errors; and

sending a cookie to the consumer computer.

92. The method of claim 80, further comprising:

at the consumer information server:

sending an electronic mail message to the consumer computer indicating that the registration information was stored.

93. A method for conducting electronic transactions over a network, comprising:

at a merchant computer:

sending, to a consumer computer, a first electronic mail message having a link including an Internet address of a consumer information server;

at the consumer computer:

selecting the link contained within the first electronic mail message received from the merchant computer, and

sending a connection request to the Internet address of the consumer information server; and

at the consumer information server:

sending, to the consumer computer, a request for registration information in response to the connection request received from the consumer computer,

receiving, from the consumer computer, registration information in response to the request, the registration information including a consumer identification number, a consumer electronic mail address and a consumer passphrase,

storing the registration information, and

sending, to the consumer computer, a second electronic mail message indicating that the registration information was stored.

EVIDENCE APPENDIX

No evidence under 37 CFR 1.130, 1.131 or 1.132 was submitted in this application.

RELATED APPEALS APPENDIX

There are no other appeals, interferences, or judicial proceedings known to Appellants, appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.